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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/981,559

04/13/98

WALLACH

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WALLACH-20

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HM22/0623

EXAMINER

ROMEO, D

ART UNIT

PAPER NUMBER

1646

DATE MAILED:

06/23/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/981,559**

Applicant(s)  
**Wallach et al.**

Examiner  
**David S. Romeo**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on 4-13-98

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-32 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

5 This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Claims 1-10 recite a plurality of disparate, structurally and functionally distinct modulators having the following disparate modulatory activities,

- 10
- a. expression,
  - b. proteolytic processing,
  - c. bioactivity, and
  - d. intracellular signaling,

via the following disparate mechanisms of actions,

- 15
- e. interacting with the intracellular domain, or
  - f. interacting with an intracellular effector protein.

For each of the above disparate modulatory activities and mechanisms of actions there are four structurally distinct modulatory compounds directed thereto, (i)-(iv), as listed in claim 2.

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These compounds are independent and distinct lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those in the prior art. Accordingly, unity of invention is lacking.

5           Groups I-XXIV, claims 1-10, are represented by combinations of a.-f. and (i)-(iv).

Group XXV, claim 11, drawn to antibodies, does not share a special technical feature with groups I-XXIV because there is no requirement that the modulators even be proteins.

10           Claims 12-32 are directed to disparate methods based on the administration or use of independent and distinct compounds lacking a common structural property entirely or lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from those in the prior art, or based on independent and distinct functions, using different starting materials and/or process steps and/or with different outcomes.

Groups XXVI-XLVI, are represented by each of claims 12-32.

15           Groups XXVI-XLVI do not share a special technical feature with groups I-XXV because the compounds used in each of groups XXVI-XLVI do not share a special technical feature with the modulator compound of groups I-XXV.

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2. The inventions listed as Groups I-XLVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the above reasons.

3. Applicant is advised that the reply to this requirement to be complete must include an  
5 election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently  
10 named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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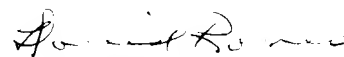
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Romeo whose telephone number is (703) 305-4050. The examiner can normally be reached on Monday through Friday from 6:45 a.m. to 3:15 p.m.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4242.

Faxed draft or informal communications should be directed to the examiner at (703) 308-0294.

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**DAVID ROMEO**  
**PATENT EXAMINER**

June 19, 1999